

Application No.: 09/817,843

Docket No.: END000008US1/
20135-00310-US**REMARKS**

Claims 1-3, 17-21 and 35-37 are now pending in this application. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Rejection Under 35 U.S.C. § 102(e)

Claims 1-3, 9 and 17-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Elenius et al. (US 6,441,487). Applicants respectfully traverse.

Applicants note that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.¹ There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.² To properly anticipate a claim, the reference must teach every element of the claim.³ "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference".⁴ "The identical invention must be shown in as complete detail as is contained in the ...claim."⁵ In determining anticipation, no claim limitation may be ignored.⁶

Regarding claim 1, the Examiner cites Elenius figures 1 and 2 as showing an electronic package comprising a dielectric substrate 22 having a major surface (top surface) and a conductive foil 30 having a smooth portion laminated to the dielectric substrate 22 major surface.

Claims 1 and 17 are hereby amended to recite a "dielectric packaging substrate." The recitation "packaging" distinguishes the basal carrier from layers of dielectric materials, such as oxides and resists, that are applied to the basal carrier substrate. The recitation "packaging" does not comprise new matter in view of original disclosure variously at pages 1 and 2.

¹ *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

² *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

³ See MPEP § 2131.

⁴ *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁵ *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁶ *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990).

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Applicants traverse on the ground that element 22 in Elenius is not a "packaging substrate." Instead, element 22 of Elenius is a "wafer passivation layer."⁷ The wafer passivation layer is described as "applied over the front surface of semiconductor wafer 14."⁸ These elements are shown in figure 2 of Elenius. The wafer passivation layer 22 therefore cannot correspond to the "dielectric packaging substrate" recited in claim 1.

Elenius therefore fails to disclose the combination of elements recited in either of claims 1 or 17, and the rejection under 35 U.S.C. § 102(e) should be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Claims 35-37 stand rejected under 35 U.S.C. § 103(a) as being obvious over Elenius et al. in view of Gotoh (US 6,204,454). Applicants respectfully traverse.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.⁹ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.¹⁰

In view of the instant amendment, it is clear that the cited art does not teach laminating a smooth surface of a conductive foil to a major surface of a "packaging substrate."

⁷ See lines 20-22 of column 6 of Elenius.

⁸ *Id.*

⁹ See MPEP §2143.

¹⁰ *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

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20135-00310-US**Conclusion**

In light of the above amendments and remarks, independent claims 1 and 17 define over the patents cited by the Examiner. The dependent claims are allowable due to their dependence upon an allowable independent claim, and for further patentable features recited therein. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass the application to issue.

Applicants believe no fee is due in connection with this Amendment. However, if a fee is due, please charge Deposit Account No. 09-0457, under Order No. END000008US1.

Date: September 24, 2003

Respectfully submitted,
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